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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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|-----------------|-------------|----------------------|---------------------|------------------|

09/996,398

11/28/2001

Jai K. Back

212/340

3095

7590

06/15/2004

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EXAMINER

STASHICK, ANTHONY D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/996,398

Applicant(s)

BAEK, JAI K.

Examiner

Anthony D Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 23, 2004
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-16 and 18-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-16 and 18-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 23, 2004 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7, 9-16 and 18-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porcher 4,702,022 in view of Dalvy et al. 5,924,218 and Mashita et al. 5,681,649. Porcher discloses all the limitations substantially as claimed including the following: a liner with multiple resilient layers (see Figure 3A especially, showing an inner liner, a resilient layer on top of the inner liner; a second resilient layer on top of the first resilient layer, and at least an outer cover layer, all shown in the heel and forefoot areas.). All the layers of the liner boot, including the vacuum layer, are provided to make the boot more comfortable on the user's foot and to protect the user's foot during use. Porcher '022 does not disclose a gel pad located between any of the layers in the toe box area or the heel area. Dalvy et al. '218 teaches that a gel pad 5 can be located between the layers of an inner boot (especially

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in the heel area as shown in Figure 1) to aid in protecting the user's foot and to help in cushioning the user's foot and fitting the boot to the user's foot. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, in view of Dalvy et al. '218, to place a gel pad in the heel area of the liner of Porcher '022 to aid in protection and comforting the user's foot within the boot. Mashita et al. '649 teaches that a gel pad, made of styrene and butadiene, can be located in many areas of footwear including the toe box area, to aid in cushioning and protecting the user's foot. Therefore, it would have been obvious to place a gel pad in the toe box area, as taught by Mashita et al. '649, between any of the layers of the toe box to aid in cushioning, protecting and comforting the user's foot within the boot. With respect to the different Shore A hardnesses of the toe box and heel counter, it appears that it would have been a mere matter of testing and optimization to find a combination of material that would provide the desired comfort and protection that would meet the desired total hardness of different areas of the boot.

Response to Arguments

4. The Applicant argues that there is no prima facie obviousness rejection because the proposed combination does not result in the claimed inventions since the prior art does not provide for and cannot provide for the location of the pads in the toe box and heel counter areas of the boot. This argument is not clearly understood. Mashita et al. '649 teaches that the pad can be placed wherever necessary to aid in cushioning the impact to a user's foot. Therefore, wherever the pad would contribute to cushioning the impact to the user's foot, either within the lining, between other pads, etc., it would have been obvious to one of ordinary skill in the art to place the pad wherever necessary to aid in cushioning a desired area of the foot, including but not limited to the toe box and the heel counter as these are parts of the boot. Mashita et al. '649 also specifically states that "cushioning materials are often used in the sole (including insole, midsole, outsole), toe, heel, ankle and vamp sections as well as

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the loose insole for cushioning and protection purposes.” (see col. 1, lines 16-19 and col. 7, lines 16-22; col 7. line 59-col. 8, line 3). Applicant argues that Mashita et al ‘649 broad statement adds nothing to the other two references. This argument is not clearly understood. Mashita et al. ‘649 teaches, in col. 7, line 53-col. 8, line 3, that the composition can be formed to the shape of the foot where it would be performing the cushioning function. Thereby, wherever it was desired to place the composition, it would follow the contours of the user’s foot. Applicant’s argument that the combination proposed must further be modified to achieve the claimed boots is also unclear for the same reason as stated above, that Mashita et al. ‘649 teaches the forming of the cushion to the part of the foot where it would be desired to be placed to perform the cushioning function. With respect to the arguments directed to the choice of styrene and 1, 3-butadiene, this argument is also not understood. It has been well settled that the choice of a material to perform the desired is well within the skill of one of ordinary skill in the art. Applicant further points out that the choice of different durometer values would not be a mere matter of testing and optimization because the references state otherwise. This argument is also not clear. Applicant points to specific passages in the art (Mashita et al/ ‘649, col. 3, lines 27-30) which applicant alleges specifically states that the exact material used is difficult and requires extraordinary skill. The emphasized statement applicant has placed in the amendment only states that “It is a key material in achieving the object of the present invention” which does not state that it is difficult, only that it is a key material in achieving the object of the present invention. Applicant further argues that Dalvy also supports that making a boot with a particular hardness is not a matter of mere testing. But, the cited portion of Dalvy only states that “the comfort/duration optimum over time is therefore very difficult to achieve.” and the portion prior to that admits that it is through testing that this can be achieved. Neither references disclose that it takes extraordinary skill but that it takes compromise between comfort and flexibility to attain the desired hardness to perform the desired function. Applicant further argues that there has not been given a reason to combine the references and states that the reason to combine

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that has been given is too broad. The reason to combine is given in the rejection above (see reasoned statements after "Therefore") and what the applicant is referring to is a response to why the prior art is relevant or analogous art. With respect to applicant's arguments towards the placement of the pad within the shoe being taught, see argument above where Mashita et al' 649 specifically defines some of the areas well-known to place the pads. Applicant's argument that the claims are not obvious because if the claims had been obvious, then those of ordinary skill in the art would have already made the claimed shoes or boots is not a proper argument against the obviousness rejection since the actual production of the boot is not required for obviousness. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant's arguments to commercial success, applicant has failed to establish a nexus between the claimed invention and evidence of commercial success. Applicant has failed to show a connection between the pads and the success of the boots, i.e. that the boots sold due to the pads and not some other feature. Also, no affidavit appears to have been filed in the application. Applicant has shown that the addition of the boot with the pads increased applicant's sales but has not shown that the addition of any new boot would not have improved the same in the same manner. Applicant has not shown that the commercial success has come from the functions and advantages as disclosed. Although applicant has attempted to show commercial success, a mere statement of success of sale of the boot as noted in the arguments

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday from 6:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony D Stashick
Primary Examiner
Art Unit 3728

ADS